

REMARKS

Favorable reconsideration of this application for the reasons noted hereinafter is respectfully requested.

Claims 1, 2, 6, 7, 9-23, 25-31, 33-38, 49 and 50 are pending in this application.

In the outstanding Office Action, Claims 1-2, 6-7, 9-23, 25-31, 33-38, and 49-50 were rejected under 35 U.S.C. § 101; Claims 1-2, 6-7, 9-17, 25, 27-28, 30, 33-34, 36-37, and 49 were rejected under 35 U.S.C. § 103(a) as unpatentable over Friz (U.S. Patent No. 5,786,994) in view of Siegel (U.S. Patent No. 6,970,804); Claims 18 and 29 were rejected under 35 U.S.C. § 103(a) as unpatentable over Friz in view of Siegel and alleged Applicant Admitted Art (hereinafter “AAPA”); Claims 19 and 21-23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Friz in view of Siegel and Lie “An Algorithm for Preventive Maintenance Policy;” Claim 20 was rejected under 35 U.S.C. § 103(a) as unpatentable over Friz in view of Siegel, Lie, and Babula (U.S. Patent No. 6,381,557); Claim 26 was rejected under 35 U.S.C. § 103(a) as unpatentable over Friz in view of Siegel and Babula; Claims 31, 35, and 38 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ridolfo (U.S. Patent No. 6,735,549) in view of Friz, Siegel, and Mairs (U.S. Patent No. 5,874,960); and Claim 50 was rejected under 35 U.S.C. § 103(a) as unpatentable over Friz in view of Siegel and Ricq (Study of CdTe and CdZnTe detectors for X-ray computed tomography).

The Official Action has noted that the Related Case Statement filed on March 8, 2010 fails to comply with the provisions of 37 C.F.R. §§1.97, 1.98 and M.P.E.P. §609. In this regard, Applicants note that the Related Case Statement filed is not an Information Disclosure Statement. As Applicants are not relying on the Examiner to be aware of a particular application belonging to the same Applicant and assignee, Applicants have submitted this material in accordance with M.P.E.P. §2004 paragraphs 9 and 10. As Applicants have

furnished this information to the Examiner as a courtesy, and no such format is required of such information, Applicants respectfully submit that no further corrective action is required.

In response to the rejection of Claims 1, 2, 6, 7, 9-23, 25-31, 33-38, and 49-50 under 35 U.S.C. § 101, page 4 of the outstanding Office Action asserts that even though Claim 1 recites a medical equipment management apparatus, this claim is nonstatutory as the Office Action interprets “unit” to encompass software *per se* embodiments. In addition, page 5 of the outstanding Office Action states that “Claim 1 recites an apparatus comprising at least some software *per se* structural imitations, and is found to be directed towards nonstatutory subject matter.” In response, Applicants note that even if the subject invention were implemented 100% in software, that would not be an adequate basis in law for a 101 rejection, in consideration of the CCPA decision, in *In re Bernhart*, 163 USPQ 611 (C.C.P.A. 1969) which stated the following:

To this question we say that if a machine is programmed in a certain new and unobvious way, it is physically different from the machine without that program; its memory elements are differently arranged. The fact that these physical changes are invisible to the eye should not tempt us to conclude that the machine has not been changed. If a new machine has not been invented, certainly a “new and useful improvement” of the unprogrammed machine has been, and Congress has said in 35 U.S.C. §101 that such improvements are statutory subject matter for a patent. It may well be that the vast majority of newly programmed machines are obvious to those skill in the art and hence unpatentable under 35 U.S.C. §103. We are concluding here that such machines are statutory under 35 U.S.C. §101....<sup>1[2]</sup>

The Federal Circuit in *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994), at page 1157 reiterated the essence of the Bernhart decision, stating:

"The reconsideration Board majority also erred in its reasoning that claim 15 is unpatentable merely because it “reads on a general purpose digital computer

‘means’ to perform the various steps under program control.” ... The Board majority stated that it would “not presume that a stored program digital computer is not within the Section 112 Para. 6 range of equivalents of the structure disclosed in the specification.”<sup>26</sup> ... Alappat admits that claim 15 would read on a general purpose computer programmed to carry out the claimed invention, but argues that this alone also does not justify holding claim 15 unpatentable as directed to nonstatutory subject matter. We agree. **We have held that such programming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.** In re Freeman , 573 F.2d 1237, 1247 n.11, 197 USPQ 464, 472 n.11 (CCPA 1978); In re Noll , 545 F.2d 141, 148, 191 USPQ 721, 726 (CCPA 1976); In re Prater , 415 F.2d at 1403 n.29, 162 USPQ at 549-50 n.29.

<sup>26</sup> The disclosed ALU, ROM and shift registers are all common elements of stored program digital computers. **Under the Board majority's reasoning, a programmed general purpose computer could never be viewed as patentable subject matter under Section 101. This reasoning is without basis in the law. The Supreme Court has never held that a programmed computer may never be entitled to patent protection. Indeed, the Benson court specifically stated that its decision therein did not preclude “a patent for any program servicing a computer.” Benson , 409 U.S. at 71. Consequently, a computer operating pursuant to software may represent patentable subject matter, provided, of course, that the claimed subject matter meets all of the other requirements of Title 35. " (Emphasis added, some citations and footnotes omitted)**

Thus, contrary to what appears to be a significant aspect of the outstanding grounds for rejection under 35 USC §112, 2nd para., and 35 USC §101, software claims are not per se unpatentable. The cited case law directed to software cases is believed to vigorously refute any such contention. Furthermore, there is nothing in the MPEP, 37 CFR, 35 USC or the case law which supports the position that software claims are per se nonstatutory.

Indeed, MPEP 2106.01, which the Examining Corps is required to follow, states:

... USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. **Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory.** (emphasis added)

Accordingly, a rejection under 35 USC §101 on the basis that software is per se nonstatutory is itself an improper refutation of this statement of the MPEP.

The outstanding Office Action rejected independent Claims 31 and 36-38 on similar grounds as Claim 1, and Applicants' respectfully submit that these claims are statutory for at least the reasons discussed above.

In regard to independent method Claims 33-35, pages 5-6 of the outstanding Office Action asserts that these claims are nonstatutory due to the claims failing the "machine or transformation" test. Applicants respectfully disagree. In the recent Supreme Court case, *In re Bilski*, the Court indicated that the machine or transformation test is not the sole test for determining whether or not a method claim is statutory. The Court indicated that method claims are nonstatutory if they are directed towards an abstract idea, laws of nature, or physical phenomenon.

Initially, Applicants respectfully submit that Claims 33-35 are not directed towards an abstract idea, as the method is for managing a medical equipment device, and thus the method is tied to a medical equipment device, which is a particular machine. In addition, the method is tied to hardware components such as a memory. The steps recited in the claims cannot be performed solely in a person's head.

Thus, Applicants respectfully submit that Claims 33-35 recite statutory subject matter in view of the recent Supreme Court case, *In re Bilski*.

Accordingly, Applicants respectfully request that the rejection of Claims 1, 2, 6, 7, 9-23, 25-31, 33-38, 49, and 50 under 35 U.S.C. § 101 be withdrawn.

With regard to the rejections under 35 U.S.C. § 103(a) based on Siegel, these rejections are respectfully traversed.

It is respectfully noted that the publication date of Siegel, June 17, 2004, is after the effective filing date of the present application, October 17, 2003. Therefore, Siegel is not prior art with respect to the present application under 35 U.S.C. §§ 102(a) or 102(b).

With regard to 35 U.S.C. § 102(e), the present application claims priority to Japanese Patent Application No. 2002-303824, filed October 18, 2002. In accordance with 37 C.F.R. § 1.55(a)(4), enclosed please find an English translation of the certified copy of this application, along with a statement that the translation is accurate. It is respectfully submitted that the enclosed document perfects the claim to priority to Japanese Patent Application No. 2002-303824 under 35 U.S.C. § 119. Further, it is respectfully submitted that the subject matter of pending Claims 1, 2, 6, 7, 9-23, 25-31, 33-38, 49, and 50 are supported by the specification of this priority document. As the filing date of Japanese Patent Application No. 2002-303824 (October 18, 2002) antedates the filing date of December 17, 2002 of Siegel, it is respectfully submitted that Siegel does not qualify as prior art with respect to the claims of the present application under 35 U.S.C. § 102. Accordingly, Siegel may not be used in the rejection of any of Claims 1, 2, 6, 7, 9-23, 25-31, 33-38, 49, and 50. Therefore, all rejections of these claims based on Siegel are traversed.

Since Applicants have not substantively amended the claims in response to any rejection on the merits, a further rejection of these claims based on newly cited prior art in the next communication *cannot properly be considered a Final Office Action*.

Accordingly, the outstanding rejections are traversed and the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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